Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR C. KECK

Appeal No. 1998-2442
Application No. 08/155,987

HEARD: JULY 11, 2000

Before CALVERT, FRANKFORT, and BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 41 and 44. Claims 32 to 40, 42, 43 and 45 to 48, the other claims remaining in the application, have been allowed.

The appealed claims are drawn to a method of making a

thrust bearing sub-assembly for an electric motor, and are reproduced in the appendix of appellant's brief.

The reference applied in the final rejection is:

Brezosky 4,293,170 Oct. 6, 1981

Claims 41 and 44 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Brezosky.[1]

Claim 41 recites, as steps (c) and (d) (emphasis added):

c) disposing a spring adjacent the thrust collar; and

d) positioning the hook projections in the apertures of the thrust plate to secure the spring between the thrust collar and the thrust plate thereby forming the thrust bearing sub-assembly.

Brezosky generally discloses all the limitations of claim 41, except that element 82, secured between thrust collar 70 and thrust plate (bearing) 62 is not a spring, as called for by steps (c) and (d), supra. Rather, Brezosky describes element 82 as a "pressed fiber lubricant seal" (col. 6, line 1), which is press fit to shaft 18 (id., line 2). Element 82 serves as

[1] An additional rejection of claims 41 and 44 as anticipated by Brezosky under 35 U.S.C. § 102(b), not having been repeated in the examiner's answer, is presumably withdrawn. Ex parte Emm, 118 USPQ 180 (Bd. App. 1957).

a barrier to oil migrating along shaft 18 (id., lines 3 and 4), as well as serving to hold collar (drive ring) 70 in position during assembly (id., lines 9 and 10).

The examiner takes the position that (answer, page 4):

> It would have been obvious to one skilled in the art at the time of the invention to provide the pressed fiber seal 82 of Brezosky in compressible form to facilitate assembly and/or ease manufacturing tolerances. An assembly operation using flexible parts involves less force than one where parts are deformed or press fit together. Also parts that are flexible do not have to be manufactured to the same tolerances as parts which are not and must closely fit together, such as parts to be press fit together.

We do not consider this rejection to be well taken. In the first place, the PTO has the burden under § 103 to establish a prima facie case of obviousness, and generally can satisfy this burden only by providing evidence of a suggestion, teaching or motivation to modify the prior art. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). A rejection under § 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the

prior art. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), quoted in In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). Here, the reasons given by the examiner as the basis of his finding of obviousness are unsupported by any evidence, and appear to be based on improper hindsight gleaned from appellant's own disclosure.

Secondly, even if we were to agree with the examiner that it would have been obvious to modify Brezosky by using a compressible and/or flexible member as the element 82 of Brezosky, claim 41's requirement of a spring would still not be met. On page 6 of the brief, appellant cites a dictionary definition of the term "spring" as "An elastic, stressed, stored-energy machine element that, when released, will recover its basic form or position . . . ." If Brezosky's member 82 were made of a compressible or flexible material it would not meet this definition of a spring,[2] nor would the use

[2] Although a spring would normally be compressible and flexible, not every compressible and/or flexible element is a

of a spring be suggested therefrom.

Accordingly, the rejection of claim 41, and of claim 44 dependent thereon, will not be sustained.

Conclusion

The examiner's decision to reject claims 41 and 44 is reversed.

Reversed

IAN A. CALVERT)
Administrative Patent Judge)
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) BOARD OF PATENT
CHARLES E. FRANKFORT)

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JENNIFER D. BAHR	)	
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